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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,834	01/20/2004	Jack J. Richards	4244P2751	4062
23504	7590	05/18/2006	EXAMINER	
WEISS & MOY PC 4204 NORTH BROWN AVENUE SCOTTSDALE, AZ 85251			COLE, ELIZABETH M	
			ART UNIT	PAPER NUMBER

1771

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/761,834

Applicant(s)

RICHARDS, JACK J.

Examiner

Elizabeth M. Cole

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

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1. The amendment filed 1/26/06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: that the impregnation comprises "filler particles".

Applicant is required to cancel the new matter in the reply to this Office Action.

2. Claims 1-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally does not provide support for the blackout film and the extruded impregnated blackout film being impregnated with filler particles and that the filler particles are capable of providing light inhibition and thermal diminution.

3. In claim 27, line 16, it appears that "coating" should be "coupling". In response to this rejection Applicant asserts that "coating" is the correct term since an acrylic latex is coated onto the blackout film in foam form. However, claim 27 reads providing an acrylic latex having a first side and a second side on an opposite side of the film and "coating said first side of said layer of acrylic latex to said first side of of said impregnated blackout film". The claim is indefinite. How is the providing step different than the coating step. The claim already provides the acrylic latex on the opposite, (i.e., first side) of the blackout film and then it recites "coating" the acrylic latex on the same

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part of the blackout film. The same problem is present in claim 29. In claim 29, line 17, it appears that "coating" should be "coupling". The same problem is present in claim 30, line 13.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Løngi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-9, 19-23, 25, 29, 32-33 of copending Application No. 10/082,039 in view of Ferzinger et al, U.S. Patent No. 4,677,016. Although the conflicting claims are not identical, they are not patentably distinct from each other because discloses a blackout drapery fabric comprising a blackout film, an acrylic latex layer and a fabric layer. US '016 does not teach employing metallic filler particles. Ferziger teaches that aluminum can be incorporated into blackout drapery by employing the aluminum in particle form in polymeric dispersions. See col. 6, lines 50-58. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed aluminum pigments as the aluminum layer in US '016, motivated by the teaching of

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Ferziger that this was an alternative known method of incorporating aluminum into blackout drapes.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-30 are rejected under 35 U.S.C. 103(a) as obvious over Samowich, U.S. Patent No. 4,409,275 in view of Ferziger et al, U.S. Patent No. 4,677,016.

Samowich discloses a drapery material which comprises a substrate which may be a woven or nonwoven fabric of natural or synthetic fibers, which may further comprise a flock layer., (col. 2, lines 19-37). While Samowich teaches flock, it does not disclose the particularly claimed types of fibers. However, since Samowich teaches that any natural or synthetic fibers can be used to make up the various fibrous layers, (see col. 2, lines 19-30), it would have been obvious to have selected the particular fibers employed

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which are well known and conventional fibers such as cotton and polyester for the flock fibers.

Cotton fabrics treated with fire retardants can be used as the substrate, (col. 3, lines 21-24). An acrylic foam is applied to the substrate. The foam can include dark pigments to produce a blackout effect. Col. 3, lines 6-20. The foam can comprise fire retardants, (col. 4, lines 14-19). A film of an acrylic latex is applied to the foam, (col. 4, lines 47-57). Both the substrate and film side can comprise a layer of flock in order to produce a material having two functional surfaces. Col. 2, lines 25-30. A polymer layer such as mylar can be applied to the opposite side of the fabric substrate. The polymer layer can comprise pigments and/or an aluminum coating. Samowich differs from the claimed invention because Samowich does not disclose the foam layer is impregnated with metal filler particles as the pigments. Ferziger discloses a blackout curtain comprising a woven textile substrate which is coated with multiple layers of foam latex, (see col. 2, lines 20-35). The foam latex may comprise polyvinyl chloride, acrylic, ethylene vinylidene chloride and others. See col. 3, lines 30-39. The foam latex comprises flame retardants, See col. 3, lines 54-59. The foam coatings include pigments which impart opacity to the layers, such as titanium dioxide, carbon black and aluminum. See col. 6, lines 50-55. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed aluminum pigments in the foam of Samowich, motivated by the teaching of Ferziger that aluminum pigments can also be used in a layer in a blackout curtain. With regard to claim 6, it is reasonable to presume that the structures would possess the claimed optical rating.

When the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention the examiner has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP §§ 2112-2112.02.

With regard to claims 13, 18-21 and 28, each of the cited references discloses the claimed structure as set forth above, however, each differs from the claimed invention because none of the references discloses adding a second fabric layer to the first fabric layer. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have added an additional fabric layer in order to improve the appearance, drape, etc of the fabric. It is noted that mere duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

9. Claims 1-3, 9-11, 12, 13, 15, 17-24, 26, 27-30 are rejected under 35 U.S.C. 103(a) as being obvious over Leaderman, U.S. Patent No. 5,741,582 in view of Ferziger et al, U.S. Patent No. 4,677,016. Leaderman discloses blackout curtain comprising a textile substrate having an inner surface, an adhesive layer which comprises an opaque pigment which corresponds to the claimed impregnated blackout film and a second layer of adhesive which may be an acrylic foam. The textile substrate may comprise woven or nonwoven fabrics comprising cotton, polyester or other man made or natural fibers. The first adhesive layer is preferably acrylic but may also comprise polyurethane. See figure 4 as well as col. 2, line 54 – col. 3, line 35. Flame

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retardants may be added to at least one layer. See col. 4, lines 23-34. Leaderman differs from the claimed invention because Leaderman does not disclose employing aluminum particles as the pigments. Ferziger discloses a blackout curtain comprising a woven textile substrate which is coated with multiple layers of foam latex, (see col. 2, lines 20-35). The foam latex may comprise polyvinyl chloride, acrylic, ethylene vinylidene chloride and others. See col. 3, lines 30-39. The foam latex comprises flame retardants, See col. 3, lines 54-59. The foam coatings include pigments which impart opacity to the layers, such as titanium dioxide, carbon black and aluminum. See col. 6, lines 50-55. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed aluminum pigments as the pigments in Leaderman, motivated by the teachings of Ferziger that such particles can be used as pigments in blackout curtains. With regard to claims 13, 18-21 and 28, each of the cited references discloses the claimed structure as set forth above, however, each differs from the claimed invention because none of the references discloses adding a second fabric layer to the first fabric layer. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have added an additional fabric layer in order to improve the appearance, drape, etc of the fabric. It is noted that mere duplication of parts has no patentable significance unless a new and unexpected result is produced. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

10. Claims 1-5, 9, 12, 14-15, 17, 22-24, 26, 27, 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Ferziger et al, U.S. Patent No. 4,677,016.



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Ferziger discloses a blackout curtain comprising a woven textile substrate which is coated with multiple layers of foam latex, (see col. 2, lines 20-35). The foam latex may comprise polyvinyl chloride, acrylic, ethylene vinylidene chloride and others. See col. 3, lines 30-39. The foam latex comprises flame retardants, See col. 3, lines 54-59. The foam coatings include pigments which impart opacity to the layers, such as titanium dioxide, carbon black and aluminum. See col. 6, lines 50-55.

11. Applicant's arguments filed 3/9/06 have been fully considered but they are not persuasive. With regard to the 112 2<sup>nd</sup> rejections set forth in the previous actions, any rejection which is not repeated above is overcome by Applicant's amendments. With regard to Applicant's arguments regarding any rejection which is maintained, the arguments are addressed above in the statement of the rejection.

12. Applicant argues that US '016 does not teach the use of metal particles. This argument is moot in view of the new grounds of rejection above.

13. Applicant argues that the acrylic film of Samowich is not the same as the impregnated blackout film and that the blackout film of Applicant's invention is preferably not acrylic and is impregnated with filler particles. However, it is noted that the particular type of film employed in the instant invention is not set forth in the claims. Also, it is noted that in addition to the acrylic film, Samowich also teaches that a film layer such as a mylar layer comprising aluminum can be applied to the opposite face of the substrate. Additionally, it is noted that Samowich teaches employing pigments in layers but does not teach employing metal filler particles. However, as set forth above, Ferziger teaches employing pigments in form of metal filler particles such as aluminum

particles. Therefore Applicant's arguments are moot in view of the new grounds of rejection.

14. With regard to Leaderman, Applicant argues that Leaderman does not teach an impregnated blackout film and does not teach thermal diminution. However, Leaderman does teach incorporating the pigment particles into the layers. Ferziger teaches employing aluminum particles as pigments in such layers. Therefore, in view of the new grounds of rejection set forth above, it would have been obvious to one of ordinary skill in the art to have employed aluminum particles as the pigments in Leaderman as taught by Ferziger. The properties associated with the pigments such as thermal diminution would necessarily be present once the particles were provided.

15. With regard to Ferziger et al, Applicant argues that Ferziger pigments the acrylic foam in order to achieve blackout properties. However, the instant claims are not specific as to the structure or composition of the film. Therefore the acrylic layers of Ferziger correspond to the claimed film. Applicant argues that Ferziger does not teach the property of thermal diminution. However, since Ferziger teaches that aluminum particles can be used, the properties associated with the aluminum particles would necessarily be present.

16. With regard to the 103 rejection, Applicant argues that neither Leaderman nor Ferziger teach that the filler particles are capable of providing thermal diminution. However, Ferziger teaches employing aluminum particles and therefore the properties associated with the particles would necessarily be present.

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17. With regard to Samowich, Applicant argues that Samowich teaches away from employing filler particles since Samowich instead teaches an aluminized film layer. However, since Ferziger teaches that aluminum particles can be employed as pigments in blackout draperies, and Samowich teaches a foam layer which is impregnated with pigments, it would have been obvious to one of ordinary skill in the art to have substituted the aluminum pigments of Ferziger for the pigments in Samowich, motivated by the expectation that the aluminum pigments were art recognized equivalents to the pigments used in Samowich.

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571)


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272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (571) 272-1478.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax number for all official faxes is (571) 273-8300.

  
Elizabeth M. Cole  
Primary Examiner  
Art Unit 1771

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